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| APPLICATION NUMBER | FILING DATE | FIRST NAMED APPLICANT | ATTY. DOCKET NO. |
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| EXAMINER |
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| ART. UNIT | PAPER NUMBER |
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DATE MAILED:

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

### OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on \_\_\_\_\_
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s) or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

- ☒ Claim(s) 1-39 is/are pending in the application.  
Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☒ Claim(s) 1-39 are subject to restriction or election requirement.

#### Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e)

#### Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449. Paper No(s) \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

--SEE OFFICE ACTION ON THE FOLLOWING PAGES--

02/26/97  
PTO 326 Rev. 9/96

BEST AVAILABLE COPY

Art Unit: 1819

***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-21, 27, 28 and 36, drawn to chimeric proteins which bind to composite DNA, classified in class 530, subclass 350.
- II. Claims 29-32, drawn to a method of identifying a specific DNA sequence in a mixture, classified in class 435, subclass 6.
- III. Claims 22, 23, 25, 26 33, 35 and 37-39, drawn to methods of decreasing or increasing transcription of a gene in a cell, classified in class 514, subclass 44.
- IV. Claims 24 and 34, drawn to a method of cleaving DNA in vitro, classified in class 435, subclass 7.1.

The inventions are distinct, each from the other because of the following reasons:

Group I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the chimeric protein of I can be used for many distinct purposes: the method of screening a specific DNA sequence of II, production of antibodies or production of vaccine or can be administered in vitro to study cell growth and development. Furthermore, the process of II does not necessarily use the protein of I.

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Group I is patentably distinct from each of III and IV because the proteins of I are not required for the methods of III and IV, nor are the methods of Group III and IV required to use the proteins of I. Furthermore, the methods and the proteins each require different searches.

Group II is patentably distinct from each of III and IV in that the methods of III and IV use different procedures and reagents to achieve divergent ends. Group II screens DNA, III involves gene therapy or increasing/decreasing gene transcription and IV involves cleavage of DNA in vitro. There is nothing on the record that the methods are obvious variants. Different searches are required for methods DNA screening, gene therapy and DNA cleavage.

Group III and IV are patentably distinct from each other, because each method uses different starting materials and procedures to achieve divergent ends. Group III involves gene therapy by increasing/decreasing gene transcription and IV involves cleavage of DNA in vitro. The various methods also are drawn to achieve divergent ends, require different search and there is nothing on the record to suggest that the methods are obvious variants.

Because the inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

A telephone call was made to Ms. Patricia Granahan on June 24, 1997 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

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Applicant is reminded that upon the cancellation of claims to a nonelected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Abdur Razzaque, whose telephone number is 703-305-4061. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00 (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jasmine C. Chambers, can be reached on 703-308-2035. The FAX phone number for art unit 1819 is 703-305-3014.

Any inquiry for a general nature or relating to the status of the application should be directed to the group receptionist whose telephone number is 703-308-0196.

Abdur Razzaque

July 14, 1997



BRIAN R. STANTON  
PRIMARY EXAMINER  
GROUP 1800